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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,902	01/16/2004	Fiorenzo Stirpe	PNJ-005CNRCE	7360
23869	7590	01/08/2008		
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER SWOPE, SHERIDAN	
			ART UNIT 1652	PAPER NUMBER
			MAIL DATE 01/08/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/758,902	STIRPE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sheridan L. Swope	1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-20, 27, 30, 32 and 36-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20, 27, 30, 32, and 36-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicants' response on November 2, 2007, to the Action on the Merits of this case mailed October 16, 2007, is acknowledged. It is acknowledged that applicants have amended Claims 15, 17, 19, 33-38, 47, and 48. Claims 11-20, 27, 30, 32, and 36-48 are pending and are hereby reconsidered.

#### ***Claim Rejections - 35 USC § 112-First Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

#### **Enablement**

Rejection of Claims 11-20, 27, and 38-42 under 35 U.S.C. 112, first paragraph lack of enablement, for essentially the same reasons stated in the prior actions, is maintained.

In support of their request that said rejection be withdrawn, Applicants provide the following arguments.

(A) Applicants maintain the arguments previously submitted.

(B) Claims 37, 38, 43, 47 and 48 have been amended to recite the limitation of polynucleotide derived from *B. spectabilis*.

These arguments are not found to be persuasive for the following reasons.

(A) Reply: See the Offices' replies of October 12, 2006 and October 16, 2007.

(B) Reply: It is acknowledged that Claims 37, 38, 43, 47 and 48 have been amended to recite the limitation of polynucleotide derived from *B. spectabilis*. However, said claims fail to recite any function for the encompassed polynucleotides or the encoded polypeptide.

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Therefore, the skilled artisan would not know how to make and use said polynucleotides without undue experimentation. See the Offices' Actions of April 18, 2006, October 12, 2006, and October 16, 2007.

For these reasons and those explained in the prior actions, rejection of Claims 11-20, 27, under 35 U.S.C. 112, first paragraph lack of enablement, is maintained.

### **Written Description**

Rejection of Claims 11-20, 27, 30, 33, and 36-48 under 35 U.S.C. 112, first paragraph insufficient written description, for the reasons stated in the prior actions, is maintained.

In support of their request that said rejection be withdrawn, Applicants provide the following arguments.

(C) Applicants maintain the arguments previously submitted.

(D) Claims 37, 38, 43, 47 and 48 have been amended to recite the limitation of polynucleotide derived from *B. spectabilis*.

These arguments are not found to be persuasive for the following reasons.

(C) Reply: See the Offices' replies of October 12, 2006 and October 16, 2007.

(D) Reply: It is acknowledged that Claims 37, 38, 43, 47 and 48 have been amended to recite the limitation of polynucleotide derived from *B. spectabilis*. However, the specification fails to describe the functions for all said encompassed polynucleotides or the encoded polypeptides. Therefore, the skilled artisan would not conclude that Applicants were in possession of the full scope of their invention. See the Offices' Actions of April 18, 2006, October 12, 2006, and October 16, 2007.

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For these reasons and those explained in the prior actions, rejection of Claims 11-20, 27, 30, 33, and 36-48 under 35 U.S.C. 112, first paragraph insufficient written description, is maintained.

***Allowable Subject Matter***

No claims are allowable.

Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Any new references were cited solely to rebut Applicants' arguments. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Regarding filing an Appeal, Applicants are referred to the Official Gazette Notice published July 12, 2005 describing the Pre-Appeal Brief Review Program.

**Final Comments**

To insure that each document is properly filed in the electronic file wrapper, it is requested that each of amendments to the specification, amendments to the claims, Applicants'

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remarks, requests for extension of time, and any other distinct papers be submitted on separate pages.

It is also requested that Applicants identify support, within the original application, for any amendments to the claims and specification.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 571-272-0943.

The examiner can normally be reached on M-F; 9:30-7 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sheridan Lee Swope, Ph.D.  
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SHERIDAN SWOPE, PH.D.  
PRIMARY EXAMINER